



RECEIVED
COMMUNICATIONS

Attorney Docket No.: 074451.P093

PATENT

#12
LDT
2-26-02

**Response pursuant to 37 C.F.R. § 1.116 -- Expedited Procedure
Examining Group 2100**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
)
Matsuda, et al.)
)
Application No: 09/191,277)
)
Filed: November 12, 1998)
)
For: METHOD AND APPARATUS FOR)
AUTOMATIC NETWORK)
CONFIGURATION)

Box AF
Commissioner For Patents
Washington, D.C. 20231

RECEIVED

FEB 26 2002

Examiner: P. Tran **Technology Center 2100**

Art Unit: 2155

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231 on:

31 JANUARY 2002

Date of Deposit

DEBORAH L. HIGHAM

Name of Person Mailing Correspondence

Deborah L. Higham 1/31/02

Signature

Date

RESPONSE

Dear Sir:

In response to the Final Office Action mailed December 31, 2001, please consider the following remarks. No claims have been amended, added or canceled. Thus, claims 1-7 and 12-30 are pending. Applicants respectfully request reconsideration of the present U.S. Patent application based on the following remarks.

Response to Statements in Office Action

As a preliminary matter, statement from the "Response to Arguments" section of the December 31, 2001 Final Office Action must be addressed. The Final Office Action states: "Applicants argued that the cited prior art... teaches away from the claimed invention." This statement is simply not true. Applicants argued

...*Lister* does not disclose automatically supplying user and group information or automatically determining service capability of a device, which clearly points out a deficiency in the anticipation rejection of the Office Action mailed July 31, 2001. See page 4 of the response mailed October 15, 2001.

The Final Office Action sets forth a characterization of anticipation based on “*Colman v. Kimberly-Clark Corp.*, 218 USPO 789.” See page 2, comment 2. This characterization is at odds with the subsequent obviousness analysis that immediately follows the anticipation requirement characterization. Claims 1 and 12 were used as examples. However, claim 1 was rejected under 35 U.S.C. § 103(a) and claim 12 was rejected under 35 U.S.C. § 102(e), so grouping these claims for detailed analysis is, at best, inconsistent. Therefore, the Office Actions mailed during prosecution of the present U.S. Patent application have not set forth a consistent basis for rejection to which Applicants can respond. Inaccurately characterizing Applicants’ arguments only furthers the confusion.

Response to Official Notice

In the Response to Applicants Arguments, the Office Action states that it “is well-known in the art” to compare the priority of two devices. Because “well-known in the art” is the standard used for taking Official Notice, Applicants assume that the Office Action is taking Official Notice of comparison of priorities of two devices. However, Applicants submit that use of priorities as claimed is not well-known in the relevant art. Therefore, in accordance with MPEP §2144.03, Applicant hereby traverses the Official Notice and requests that the Examiner either (1) cite a prior art reference that supports such a position pursuant to MPEP § 706.02(a); (2) submit an affidavit pursuant to C.F.R. § 1.104(d)(2); or (3) withdraw the obviousness assertion.